

REMARKS

Reconsideration of the above noted application is respectfully requested.

Claim Status

Claims 1, 12, 29, and 35 are hereby amended to include the clarifying language “physically independent” for the wicking layer. Support for this amendment is found on page 9, lines 25-27, on page 13, lines 13-18, on page 14, lines 25-30, and in Item 13 of Figure 1. Claims 14-28, 31-34, and 37-42 are hereby cancelled. Therefore, claims 1-13, 29-30, and 35-36 are pending.

No new matter is added by way of this amendment.

Telephone Interview

Applicants and the undersigned appreciate the Examiner’s time and consideration during a telephone interview between Examiner Kidwell and the undersigned held January 12, 2005. Applicants note for the record that the initial interview was requested and scheduled with the presence of the Supervisory Examiner Schwartz, however, due to a scheduling conflict, Examiner Schwartz was unable to attend the telephone interview. Applicants requested a summary of the interview, however, to date, no summary has been received. Briefly, the undersigned and the Examiner reviewed the missing Information Disclosure Statements and reviewed the rejections pertaining to Hammons et al. for clarification. Additional details are provided in the following remarks.

Election/Restriction

The Examiner has requested that claims 14-28, 31-34 and 37-42 be cancelled as they were drawn to an invention nonelected with traverse. Accordingly, Applicants hereby cancel claims 14-28, 31-34 and 37-42.

Information Disclosure Statement

The Examiner has noted that the Information Disclosure Statements (IDS) submitted on May 21, 2001 and July 12, 2001 fail to comply with 37 C.F.R. 1.98(a)(1). During a conference call on January 12, 2005, the Examiner stated that portions of the submissions were missing from the file. The undersigned and Examiner agreed to the resubmission of the complete IDS papers, including the return postcards, from May 21, 2001 and July 12, 2001 with copies of any non-U.S. patents/patent applications. The Examiner has stated that copies of U.S. patent and U.S. Patent applications were not required. Accordingly, Applicants submit herewith complete copies of the IDS submissions (but excluding U.S. patents and U.S. patent applications) of May 21, 2001 at Tab A, and of July 12, 2001 at Tab B.

Anticipation (35 U.S.C. §102(b))

Claims 1-6, 10-13, 29-30 and 35-36 stand rejected under 35 U.S.C. §102(b) as anticipated by Hammons et al. (U.S. Patent No. 5,647,863). Specifically, the Examiner states that all of the limitations of the noted claims are disclosed by Hammons et al. (see pages 3-6 of the November 2, 2004 Office Action).

In the telephone interview of January 12, 2005, the rejection of claim 1 was clarified in that the Examiner stated that her reliance on Hammons for a "wicking layer" is defined as items 46 and 48. Item 46 in Hammons is designated as a storage/distribution layer; item 48 is designated as an indicator member. The Examiner stated that the two layers work collectively to provide the features of the claimed wicking layer.

The Examiner also clarified the rejection of claim 12. In the telephone interview, the Examiner explained that the rejection is based on Hammons' acquisition layer (44) as the storage layer, and Hammons' storage layer (46) as the wicking layer. Accordingly, the Examiner states that Hammons teaches a wicking layer having hardwood pulp (12:16-28) and states that the ratio between wicking to storage layer is taught at col. 11, lines 11-15 because the Examiner has re-designated the interpretation of layers to fit accordingly (see page 3 of November 2, 2004 Office

Action). According to the Examiner, because claim 12 is an independent claim, she is not required to interpret Hammons in the same way when crafting a rejection of two separate claims (Telephone interview, January 12, 2005). As stated in the Office Action, the Examiner is of the opinion that “names given to layers are just that” (see page 7 of the November 2, 2004 Office Action). During the telephone interview, the Examiner stated that because the layers received fluid, that in essence they were functioning in the same manner - that they could all receive, store and pass on fluid. This rejection is respectfully traversed, and reconsideration is respectfully requested.

Regarding the Examiner’s interpretation of Hammons, applicants respectfully disagree with the Examiner’s position on naming layers. Applicants submit that any prior art cited against an application is to be interpreted by the disclosure combined with knowledge of one skilled in the art. *See In re Graves*, 69 F.3d 1147, 36 USPQ2d 1667 (Fed. Cir. 1995), *cert. denied*, 517 U.S. 1124 (1996). Applicants submit that one skilled in the art would know that particular absorbent layers are unique, that they are defined distinctly in the art, that they serve very different functions, and thus absorbent layers would not be considered interchangeable by one of ordinary skill in the art. As such, applicants respectfully submit that Hammons teaches an absorbent article with a topsheet (38) and backsheet (40) and an absorbent core (42) (see col. 4:58-67). The absorbent core of Hammons comprises three members: an acquisition layer (44), a storage/distribution layer (46), and an indicator layer (48). Applicants respectfully disagree with the Examiner’s interpretation of Hammons as having a wicking layer(s). Nowhere in Hammons is there a separate layer comparable to the wicking layer of the presently claimed invention. The wicking layer of the claimed invention is disposed below a storage layer and which,

... efficiently transports fluid vertically for a greater distance than is possible in a unitary or homogenous structure of comparable overall density and also distributes the fluid laterally into an adjacent fluid storage layer and does so at an overall density and product stiffness such that the product remains soft, flexible, and comfortable to wear.

(see page 9 lines, 21-27 of the specification).

However, to further clarify the presently claimed invention, independent claims 1, 12, 29, and 35 are hereby amended to clarify that the wicking layer is “physically independent” from the other layers of the absorbent core. As noted above, support for this amendment is found on page 9, lines 25-27, on page 13, lines 13-18, on page 14, lines 25-30, and in Item 13 of Figure 1. As there is no separate wicking layer in Hammons, the presently claimed invention cannot be anticipated by Hammons. Additionally, the presently claimed invention would not have been obvious over Hammons as there is no motivation or teaching in Hammons to devise a separate layer capable of wicking properties. Only through impermissible hindsight might one skilled in the art be motivated to devise a separate wicking layer. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”). Thus, applicants submit that Hammons fails to anticipate and/or render obvious the presently claimed invention. Applicants request that the rejection of claims 1-6, 10-13, 29-30 and 35-36 be withdrawn.

Obviousness (35 U.S.C. §103(a))

Claims 7-9 stand rejected under 35 U.S.C. §103(a) as obvious over Hammons in view of U.S. Patent No. 5,919,177 (to Georger et al.) and U.S. Patent No. 4,324,247 (to Aziz). The Examiner states that although Hammons fails to associate a numerical value to rewet characteristic, that it would be obvious to one skilled in the art to correspond a “low rewet value” to a value of less than one gram. The Examiner relies on Georger (U.S. Patent No. 5,919,177) and Aziz (U.S. Patent No. 4,324,247) as support for rewet values of less than one gram. Therefore, according to the Examiner, it would be obvious for one skilled in the art to combine these references to arrive at the presently claimed invention. This rejection is respectfully traversed, and reconsideration is respectfully requested.

In response, applicants submit that Hammons does not teach the presently claimed invention for the reasons stated above. Hammons does not teach an absorbent core with a physically separate wicking layer. The Examiner’s reliance on column 5, lines 17-19 is misplaced in that this specific excerpt is a description applying to the topsheet of Hammons, not to the

absorbent core which is defined in Hammons as including the acquisition layer (44), storage layer (46), and the indicator layer (48). In this instance, the categorization of the layers is clearly not just different by name, but is in fact a clear description of a topsheet, separate from any absorbent core. Therefore, in addition to the absence of the wicking layer, Hammons fails to teach low rewet characteristics for an absorbent core.

Providing the teachings of Georger and Aziz with Hammons fail to achieve the presently claimed invention. Georger teaches a low rewet value for an absorbent material with an apertured, film-coated, lofty nonwoven fabric. Applicants submit that even with this teaching, the prior art does not arrive at the presently claimed invention. Likewise, Aziz teaches a range of rewet values above and below 1.0 gram. However, again, this teaching fails to provide the missing teachings of Hammons. Furthermore, there is no motivation or suggestion to combine these separate references to arrive at the claimed invention. *See Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 103 F.3d 1538, 41 USPQ2d 1238 (Fed. Cir. 1997) *cert denied*, 521 U.S. 1122, 1244 (1997). (“A determination of obviousness must involve more than indiscriminately combining prior art; a motivation or suggestion to combine must exist.”). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art that would have led a person of ordinary skill to combine or modify the references. *See In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995); *see also In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Simply because one reference teaches “low rewet values” in a type of absorbent layer does not provide any motivation to form the same low rewet values in an entirely different layer with an entirely different purpose.

Furthermore, the Examiner uses improper hindsight in the present rejection. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); *see also In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.”).

The Examiner has failed to provide any real evidence as to why one of ordinary skill would have been motivated to combine the references. *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("This showing [motivation] must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not evidence."). Therefore, for the reasons discussed above, applicants submit that Hammons, in combination with Georger or Aziz, fails to teach the presently claimed invention. Applicants therefore request that the rejection be withdrawn.

Conclusion

In view of the above amendment, applicants believe the pending application is in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: February 2, 2005

Respectfully submitted,

By Sandra S. Lee
Sandra S. Lee

Registration No.: 51,932
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant